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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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PHILIPS INTELLECTUAL PROPERTY & STANDARDS			WRIGHT, KAINOA	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,729	<b>Applicant(s)</b> LAMBERT ET AL.
	<b>Examiner</b> KAINOA BK WRIGHT	<b>Art Unit</b> 2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 03 May 2005.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 03 May 2005 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1668)  
 Paper No(s)/Mail Date 12/1/06; 5/3/06

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for reciting both an apparatus and the method steps for using the apparatus. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). Accordingly, only the apparatus will be examined.
3. Claims 3 and 9-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 3: The term “regular data stream” is indefinite, as there is no indication of what constitutes regular. For the purpose of examination, a regular data stream will be considered as meaning Cartesian coordinates.

Regarding Claims 9-10: The claim recites, “[the] method according to claim 8, characterized in that the measurements comprise angle measurements”, such measurements referring to measurements being performed on the record carrier to retrieve the parameter information (claim 8). It is unclear what applicant means by an “angle measurement”. Specifically, if I were to hand someone a disk, or a “record carrier”, and say to them, “make an angle measurement,” they would have no clue what I was talking about. The same holds true for the “angular distance measurement” of

claim 10. Hence the claims are insolubly ambiguous and are precluded from examination.

Regarding Claims 11-13: The claims are insolubly ambiguous as containing the unclear language of claims 9-10 from which they depend.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson (US 6,463,026).

Regarding Claim 1: Anderson teaches an optical disk (i.e. a record carrier) having an opaque paper label layer (col.2, ll.29) onto which a user writes image information with a pen or marker (col.2, ll.54-55), the optical disk adhering to a standardized condition with respect to a physical parameter (i.e. the existence of a non-data side of the disk, standard in single side recordable disks such as the one of Anderson).

Inherent in the process of a user writing information on the label with a pen are the steps of retrieving label information (i.e. the user deciding what to write); retrieving parameter information (i.e. user determines whether or not the non-data side has a markable label) on the physical parameter (i.e. the non-data side of the disk), the parameter information being of a higher precision than the standardized physical

parameter (i.e. determining that the non-data side is a markable label layer is more precise than just knowing there is a non-data side); and writing the label information on the disk using the parameter information (i.e. user determines markable label and marks according to label information).

Regarding Claim 2: Anderson teaches the record carrier having a circular form and writing image data in polar form (Fig.1).

Regarding Claim 3: Anderson teaches recording in Cartesian coordinates, thus constituting a "regular" data stream(Fig.4).

Regarding Claims 4-5: In the above method of claim 1, with respect to Anderson, the retrieving of the parameter information is accomplished by the user looking at the disk and determining if the non-data side has a markable label attached. The act of viewing and determining is considered to constitute reading the parameter information (i.e. whether or not the non-data side is a markable label) from the disk.

Regarding Claim 6: The opaque label is considered a unique identifier, as a non-markable label is generally not opaque. The database is considered to be the user's brain. Hence, it is provided that the parameter information (i.e. the markability of the label) is read from the database (i.e. determined by the brain) using the unique identifier (i.e. noticing the opaque paper label).

Regarding Claim 8: Determining the opaqueness and paperness of the label is considered to be a measurement of the non-data side of record carrier.

Regarding Claim 14: A means for retrieving label information is considered to be the user's imagination; a means for retrieving parameter information is considered to be

the user's eyes; and a means for writing the label information is considered to be the pen.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson (US 6,463,026).

Anderson teaches a user writing on a disk label using a pen. Anderson further teaches parameter information (i.e. the markability of the label) being read from a database (i.e. determined by the brain) using a unique identifier (i.e. the opaque paper label).

Anderson fails to explicitly teach the database being read out via the internet.

The USPTO has had in operation, a patent search database, available to the public, since at least the year 2000. As Anderson was published in this database on 10/8/2002, hence a user of Anderson has had access to the Anderson document via internet and thus could determine the parameter information (i.e. the markability of the label) by reading that the label is markable from the USPTO database using the unique identifier (i.e. the label is opaque and paper).

Hence, it would have been obvious to one of ordinary skill in the art (i.e. an average user) to have noticed the paper opaque label and used the internet to find

information on the markability of such labels, by looking up Anderson or other similar documents. One would have been motivated to do this in order to determine if they could write on their disk.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bronson (US 6,771,297).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAINOA BK WRIGHT whose telephone number is (571)272-5102. The examiner can normally be reached on M-F 8:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Luu can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/533,729  
Art Unit: 2861

Page 7

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3/25/08

/LUU MATTHEW/  
Supervisory Patent Examiner, Art Unit 2861